

Application No. 10/031,361  
Response to Office Action dated October 27, 2003  
Reply to Office Action of September 25, 2003

**REMARKS**

Claims 1-25 are pending in the application, with Claim 1 being the sole independent claim.

Claim 13 has been objected to but the Office Action indicates that the invention defined thereby is otherwise allowable.

Claims 1-12 and 14-25 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,516,812 (Chu). Applicant traverses this Section 102(b) rejection.

Applicant invites the Examiner's attention to the fact that the subject application is the U.S. National Phase of International Patent Application No. PCT/US00/16312. During prosecution of that International Patent Application an International Search Report was issued on November 14, 2000, in which no documents were cited as "X" documents. And U.S. Patent No. 5,516,812 (Chu) was cited, though as a "Y" document. Thereafter, the International Preliminary Examining Authority (there, the U.S. Patent and Trademark Office) issued a Written Opinion on August 10, 2001. In that Written Opinion, Claims 1-11 and 14-23 (corresponding to those same claim numbers pending herein) were determined to lack novelty as allegedly being anticipated by the '812 patent and lack inventive step as

Application No. 10/031,361  
Response to Office Action dated October 27, 2003  
Reply to Office Action of September 25, 2003

allegedly being obvious over the '812 patent. [Claims 12-13 were determined to meet the criteria for patentability set out in PCT Article 33(2)-(4).] Applicant replied to that Written Opinion on October 1, 2001 and argued that Chu is directed to radiation and moisture curable silicone compositions having a vinyl-terminated silicone fluid, a radiation and moisture curable silicone fluid, and a photoinitiator. Applicant continued that Chu speaks to silicone fluids, which are readily recognized as polymers that are linear. That is, the silicone fluids of Chu are described to be end-capped and linear in structure (see e.g., col. 3, lines 38-61), indicating that these silicone fluids react through their terminal ends to form a cured product that extends through those ends in a linear manner.

In contrast to Chu, Applicant argued the present invention employs a polyorganosiloxane and silicone resin, together with a cure catalyst. The polyorganosiloxane is comparable to the silicone fluid of Chu, in that it is a linear silicone polymer with reactive end groups. Reference to the specification at page 9, line 23 et seq. describes a polyorganosiloxane being linear with a molecular size of about 50 siloxane units, and certain reactive groups on the terminal ends. Page 10, line 17 indicates that "[g]enerally, it is

Application No. 10/031,361  
Response to Office Action dated October 27, 2003  
Reply to Office Action of September 25, 2003

convenient to use a linear polyorganosiloxane having  
(meth)acrylate groups terminating the silicone."

However, Applicant defines the silicone resin in very particular ways (see above and Claims 1 and 2), which are not taught, disclosed or suggested by Chu.

The silicone resin is used in the present invention to provide reinforcement in the cured reaction product. The reinforcing ability comes from the non-linear structure of these resins and the functional groups that may react with the functional groups on the polyorganosiloxane.

A review of the Examples section of the Specification will readily point out the superior results obtained when using the silicone resins as defined in the subject application to provide reinforcement to the cured reaction products formed from the polyorganosiloxane and silicone resin.

M.A. Brook, Silicon in Organic, Organometallic, and Polymer Chemistry, p. 319, J. Wiley & Sons, Inc., New York (2000) refers to the use of MQ resins (a common way of describing silicone resins generally, see also Specification, page 4, line 23 - page 5, line 2) as "'spidery' 3D structures" and as being "useful materials for reinforcing silicones".

Thus, Applicant argued and respectfully submits here that Chu speaks to the use of two silicone fluids (see e.g.

Application No. 10/031,361  
Response to Office Action dated October 27, 2003  
Reply to Office Action of September 25, 2003

Claim 1 thereof), having linear structures with reactive end groups. Chu does not however disclose, teach or suggest the use of a silicone resin, particularly as defined herein, as that term is known in the art and used by the Applicant as a three dimensional, networked silicone-based structure. Nor does Chu disclose, teach or suggest the use of a silicone resin to reinforce a silicone composition once cured through a reaction between reactive groups on the polyorganosiloxane and the silicone resin.

On February 14, 2002 an International Preliminary Examination Report ("IPER") was issued, in which the Authorized Officer agreed with Applicant's position and determined that each of Claims 1-23 met the criteria set out in PCT Article 33(2)-(4). In sum and substance, the explanation given in the IPER was that Chu did not teach the silicone resin as defined and used in Applicant's invention which are three dimensional structures verses the linear silicone fluids taught by Chu, and Chu did not teach using such silicone fluids to reinforce polyorganosiloxanes. The claims that entered the U.S. National Phase correspond to those which were prosecuted during the international phase, save for the amendments made in Applicant's Preliminary Amendment of January 17, 2002.

Application No. 10/031,361  
Response to Office Action dated October 27, 2003  
Reply to Office Action of September 25, 2003

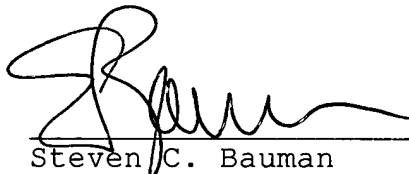
Applicant also notes that the Authorized Officer during the international phase is the very same individual who is the instant Examiner's supervisor -- that is James Seidleck.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Section 102 rejection and prompt passage to issue of the subject application.

#### **CONCLUSION**

Applicant's undersigned attorney may be reached by telephone at (860) 571-5001, by facsimile at (860) 571-5028, or by email at [steve.bauman@loctite.com](mailto:steve.bauman@loctite.com). All correspondence should continue to be directed to the address given below.

Respectfully submitted,



Steven C. Bauman  
Attorney for Applicant  
Registration No. 33,832

HENKEL LOCTITE CORPORATION  
Legal Department  
1001 Trout Brook Crossing  
Rocky Hill, Connecticut 06067

\\LCHQMAIN\APPS\User\BaumanSt\WORD\PATENTS\Amendments&Responses\LC-366-PCT-US Response to Office Action.doc